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Attorney for Plaintiff

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CLERK, U.S. DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

BY: 

DEPUTY

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA

'08 CV 0337 JAH RBB

HST Automotive, LLC, a California Limited
Liability Company; and Ronaele, Inc., a
Nevada Corporation;

Plaintiffs,

vs.

DENICE HALICKI, an individual; THE
ORIGINAL GONE IN 60 SECONDS, LLC, a
Delaware Limited Liability Company;
HALICKI FILMS, LLC, a California Limited
Liability Company; and ELEANOR
LICENSING, LLC, a Delaware Limited
Liability Company; and DOES 1 – 10,
inclusive;

Defendants

Case No.:

**COMPLAINT FOR DECLARATORY
JUDGMENT OF NON-INFRINGEMENT
OF TRADEMARK, TRADE DRESS, AND
COPYRIGHT**

Plaintiffs HST Automotive, LLC, and Ronaele, Inc., (collectively referred to as
"Plaintiffs") hereby complain as follows:

///

1 COMPLAINT FOR DECLARATORY RELIEF OF
NON-INFRINGEMENT OF TRADEMARK,
TRADE DRESS, AND COPYRIGHT

ORIGINAL

THE PARTIES

1. Plaintiff HST Automotive, LLC, a California Limited Liability Company, with its principal place of business in San Diego County, State of California.

2. Plaintiff Ronaale, Inc., a Nevada Corporation, with its principal place of business in Henderson Nevada.

3. Plaintiffs are informed and believe, and based thereon allege, that Defendant Denice Halicki is an individual having a principal place of residence in Los Angeles County, State of California.

4. Plaintiffs are informed and believe, and based thereon allege, that Defendant THE ORIGINAL GONE IN 60 SECONDS, LLC is a Delaware Limited Liability Company, with its principal place of business in Los Angeles County, State of California.

5. Plaintiffs are informed and believe, and based thereon allege, that Defendant HALICKI FILMS, LLC is a California Limited Liability Company, with its principal place of business in Los Angeles County, State of California.

6. Plaintiffs are informed and believe, and based thereon allege, that Defendant ELEANOR LICENSING, LLC is a Delaware Limited Liability Company, with its principal place of business in Los Angeles County, State of California.

7. Plaintiffs are not aware of the true names and capacities of Defendant DOES 1 through 10, inclusive, are therefore sue these defendants by such fictitious names. When the true names and capacities of Defendants DOES have been ascertained, Plaintiffs will amend the Complaint to set forth such specific facts.

8. Defendants DENICE HALICKI, THE ORIGINAL GONE IN 60 SECONDS, LLC, HALICKI FILMS, LLC, and ELEANOR LICENSING, LLC, and DOES 1 – 10, collectively referred to as "Defendants."

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JURISDICTION AND VENUE

10. Jurisdiction in this Court is proper as this Complaint concerns matters having exclusive federal jurisdiction, including the Trademark Act of 1946, as amended, 15 U.S.C. §1051 et seq. , The Copyright Act of 1976, as amended, 17 U.S.C. §401 et seq., and California common law.

11. This Court has personal jurisdiction over Defendants as they are conducting business in California, and their principal place of business is within California.

12. Venue is proper in this matter as Plaintiffs are engaged in business, and Defendants have been engaging, and will continue to engage, in business within this judicial district.

BACKGROUND FACTS

13. On February 7, 2008, Defendants transmitted through their attorney, a letter alleging Trademark, Trade Dress, and Copyright Infringement violations. A copy of the letter is attached as Exhibit 1.

14. Defendants specifically allege that Plaintiffs have been manufacturing, producing and/or selling automobiles under the name "RONEALE".

15. Defendants specifically allege that the automobiles provided by Plaintiffs are exact replicas of a vehicle featured in the motion picture "Gone in 60 Seconds."

16. Defendants specifically allege that Defendants "own the exclusive rights to the copyright, trademark, trade dress (which includes the look) of the character of "Eleanor" from the motion picture."

17. Plaintiffs allege that any vehicles produced by Plaintiffs are not exact replicas of any vehicle featured in the movie "Gone in 60 Seconds."

18. Plaintiffs allege that any vehicles produced by Plaintiffs do not infringe any copyright, trademark or trade dress rights owned by Defendants.

1 19. On information and belief, and based thereon, Plaintiffs allege that Defendants do
2 not own the exclusive rights to the copyright, trademark or trade dress of the character of
3 "Eleanor" from the motion picture.

4
5 FIRST CLAIM FOR RELIEF

6 DECLARATORY RELIEF OF NON-INFRINGEMENT OF TRADEMARK
7

8 13. Plaintiffs reallege and incorporate by this reference all prior allegations as though
9 fully stated herein.

10 14. Plaintiffs dispute the ownership of any "Eleanor" trademark by Defendants.

11 15. Plaintiffs, on information and belief, and based thereon allege, that the true owner
12 of the Eleanor trademark is not Defendants, but rather, the original creator of the 1967 Mustang
13 Shelby GT-500 Fastback, namely Carroll Shelby.

14 16. Moreover, even assuming pro-arguendo that Plaintiffs produced a vehicle bearing
15 the name "Roneale", Plaintiffs allege that such use is not a violation of any trademark rights
16 which may exist in the name "Eleanor".

17 17. Moreover, even assuming pro-arguendo that Plaintiffs produced a vehicle bearing
18 the name "Roneale", Plaintiffs allege that such use is not a violation of any trademark rights of
19 Defendants.

20
21 SECOND CLAIM FOR RELIEF

22 DECLARATORY RELIEF OF NON-INFRINGEMENT OF TRADE DRESS
23

24 18. Plaintiffs reallege and incorporate by this reference all prior allegations as though
25 fully stated herein.

26 19. Plaintiffs dispute the ownership of any trade dress by Defendants.
27
28

1 20. Plaintiffs, on information and belief, and based thereon allege, that the true owner
2 of the Eleanor trade dress is not Defendants, but rather, the original creator of the 1967 Mustang
3 Shelby GT-500 Fastback, namely Carroll Shelby.

4 21. Moreover, even assuming pro-arguendo that Plaintiffs produced a vehicle having
5 the appearance of the original 1967 Mustang Shelby GT-500 Fastback, Plaintiffs allege that such
6 use is not a violation of any trade dress rights of Defendants.

7
8 THIRD CLAIM FOR RELIEF

9 DECLARATORY RELIEF OF NON-INFRINGEMENT OF COPYRIGHT
10

11 22. Plaintiffs reallege and incorporate by this reference all prior allegations as though
12 fully stated herein.

13 23. Plaintiffs dispute the ownership of any "Eleanor" copyright by Defendants.

14 24. Plaintiffs, on information and belief, and based thereon allege, that the true owner
15 of any copyright is not Defendants, but rather, the original creator of the 1967 Mustang Shelby
16 GT-500 Fastback, namely Carroll Shelby.

17 25. Moreover, even assuming pro-arguendo that Plaintiffs produced a vehicle
18 appearing like the 1967 Mustang Shelby GT-500 Fastback, Plaintiffs allege that such use is not a
19 violation of any copyright rights of Defendants.

20
21 WHEREFORE, Plaintiffs pray for judgment as follows:
22

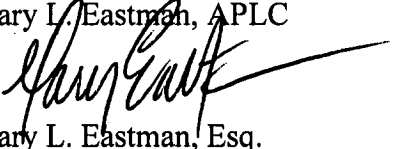
23 1. Plaintiffs be granted a Declaratory Judgment of Trademark Non-Infringement
24 with regard to Defendants allegations of trademark infringement of the word "Eleanor;"

25 2. Plaintiffs be granted a Declaratory Judgment of Trade Dress Non-Infringement
26 with regard to Defendants allegations of trade dress infringement of the "look" of the mustang
27 featured in the motion picture "Gone in 60 Seconds;" and
28

1 3. Plaintiffs be granted a Declaratory Judgment of Copyright Non-Infringement with
2 regard to Defendants allegations of copyright infringement of any rights in the motion picture or
3 vehicle identified as "Eleanor."
4
5

6 Dated this February 19, 2008

7 Gary L. Eastman, APLC

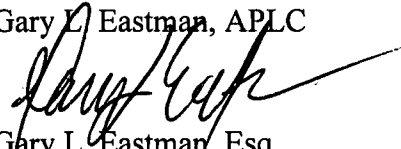
8 
9 Gary L. Eastman, Esq.
10 Attorney for Plaintiffs

JURY TRIAL DEMAND

Plaintiffs hereby demand a trial by jury.

Dated this February 19, 2008

Gary L. Eastman, APLC



Gary L. Eastman, Esq.
Attorney for Plaintiffs

EXHIBIT 1

Letter from Defendants' Counsel alleging Trademark, Trade Dress and Copyright Infringement

DRIVER STEVEN KATZMAN
BROCKEN WOODS DRIVE

7013-001/603664

February 7, 2008

VIA FACSIMILE AND OVERNIGHT DELIVERY

Gary Beck
HST Automotive, LLC
8985 Crestmar Pointe
San Diego, California 92121

VIA OVERNIGHT DELIVERY

Todd Boretto
Ronaele, Inc.
1367 Cadence Street
Henderson, Nevada 89052

Re: Infringement of "Eleanor" Trademark, Trade Dress, Copyright

Dear Messrs. Beck and Boretto:

This firm represents Denise Shakarian Halicki, The Original Gone in 60 Seconds, LLC, Halicki Films, LLC and Eleanor Licensing, LLC (collectively, the "Halicki Parties").

We are informed and believe that your companies are and have been manufacturing, producing and/or selling automobiles under the name "Ronaele" – which simply is the name "Eleanor" spelled backwards – through an agreement with Ronaele, LLC, Ronaele Mustang, Inc. and/or Edward Monfort. We are further informed and believe that these "Ronaele" Mustangs are exact replicas of the star character known as "Eleanor" from the motion picture "Gone in 60 Seconds."

Please be advised that Mr. Monfort and his entities do not own any rights or interest in "Eleanor" or any derivation thereof, and do not have the right to license the same to your companies. Rather, the Halicki Parties own the exclusive rights to the copyright, trademark, trade dress (which includes the look) of the character of "Eleanor" from the motion picture, "Gone in 60 Seconds" – both the original and the remake – for purposes of merchandising. They alone own the right, among other things, to produce, manufacture, market and sell any vehicle bearing the name and/or look of "Eleanor." For this reason, the Halicki Parties have filed a lawsuit in federal court against Mr. Monfort and his entities for, among other things, trademark infringement and copyright infringement.

Mr. Gary Beck
Mr. Todd Boretto
February 7, 2008
Page 2

Accordingly, the Halicki Parties demand that, within ten (10) calendar days of your receipt of this letter, you:

- (1) confirm in writing that you will immediately and forever cease and desist from using the name "Ronaele" for any purpose relating to automobiles;
- (2) confirm in writing that you will immediately and forever cease and desist from creating, manufacturing, producing, marketing or selling any vehicles (electric or otherwise) or kits for vehicles bearing the name, look or character of "Eleanor" from "Gone in 60 Seconds";
- (3) confirm in writing that you will immediately and forever cease and desist from consulting or acting in concert with, participating in or assisting any other person or entity in the creation, manufacture, production, marketing or sale of any vehicles (electric or otherwise) or kits of vehicles bearing the name, look or character of "Eleanor" from "Gone in 60 Seconds"; and
- (4) provide copies of all financial records and documents relating to the costs, sales, profits and other financial data for the Ronaele vehicles produced by you.

If we do not receive confirmation of each of the above within ten (10) calendar days of your receipt of this letter, please be advised that the Halicki Parties will take all necessary action to preserve and enforce their rights against you, including, but not limited to, initiating legal action for copyright and trademark infringement and seeking relief in the form of damages, punitive damages, and permanent injunction.

Govern yourself accordingly.

Very truly yours,

Allan Browne

AB/ic
cc: Sonia Y. Lee, Esq.

JS 44 (Rev. 11/04)

CIVIL COVER SHEET

The JS 44 civil cover sheet and the information contained herein neither replace nor supplement the filing and service of pleadings or other papers as required by law, except as provided by local rules of court. This form, approved by the Judicial Conference of the United States in September 1974, is required for the use of the Clerk of Court for the purpose of initiating the civil docket sheet. (SEE INSTRUCTIONS ON THE REVERSE OF THE FORM.)

I. (a) PLAINTIFFS

HST Automotive, LLC, a California Limited Liability Company, and
Ronaale, Inc., a Nevada Corporation

(b) County of Residence of First Listed Plaintiff San Diego
(EXCEPT IN U.S. PLAINTIFF CASES)

(c) Attorney's (Firm Name, Address, and Telephone Number)

Gary L. Eastman, Esq.
707 Broadway Street, Suite 1800, San Diego, CA 92101 (619) 230-1144

DEFENDANTS

Denise Halicki (individual); The Original Gone in 60 Seconds, LLC;
Halicki Films, LLC, and Eleanor Licensing, LLC

County of Residence of First Listed Defendant Los Angeles, CA
CLERK, U.S. DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA (U.S. PLAINTIFF CASES ONLY)

NOTE: IN LAND CONDEMNATION CASES, USE THE LOCATION OF THE
LAND INVOLVED.

BY: 08 CV 0337 JAH RBB
Attorneys (If known)

II. BASIS OF JURISDICTION (Place an "X" in One Box Only)

- ☐ 1 U.S. Government Plaintiff ☒ 3 Federal Question (U.S. Government Not a Party)
- ☐ 2 U.S. Government Defendant ☐ 4 Diversity (Indicate Citizenship of Parties in Item III)

III. CITIZENSHIP OF PRINCIPAL PARTIES (Place an "X" in One Box for Plaintiff and One Box for Defendant)

- Citizen of This State ☐ 1 PTF ☐ 1 DEF ☐ 1 Incorporated or Principal Place of Business In This State ☒ 4 PTF ☒ 4 DEF
- Citizen of Another State ☐ 2 PTF ☐ 2 DEF ☐ 2 Incorporated and Principal Place of Business In Another State ☐ 5 PTF ☐ 5 DEF
- Citizen or Subject of a Foreign Country ☐ 3 PTF ☐ 3 DEF ☐ 3 Foreign Nation ☐ 6 PTF ☐ 6 DEF

IV. NATURE OF SUIT (Place an "X" in One Box Only)

CONTRACT	TORTS	FORFEITURE/PENALTY	BANKRUPTCY	OTHER STATUTES
<input type="checkbox"/> 110 Insurance <input type="checkbox"/> 120 Marine <input type="checkbox"/> 130 Miller Act <input type="checkbox"/> 140 Negotiable Instrument <input type="checkbox"/> 150 Recovery of Overpayment & Enforcement of Judgment <input type="checkbox"/> 151 Medicare Act <input type="checkbox"/> 152 Recovery of Defaulted Student Loans (Excl. Veterans) <input type="checkbox"/> 153 Recovery of Overpayment of Veteran's Benefits <input type="checkbox"/> 160 Stockholders' Suits <input type="checkbox"/> 190 Other Contract <input type="checkbox"/> 195 Contract Product Liability <input type="checkbox"/> 196 Franchise	PERSONAL INJURY <input type="checkbox"/> 310 Airplane <input type="checkbox"/> 315 Airplane Product Liability <input type="checkbox"/> 320 Assault, Libel & Slander <input type="checkbox"/> 330 Federal Employers' Liability <input type="checkbox"/> 340 Marine <input type="checkbox"/> 345 Marine Product Liability <input type="checkbox"/> 350 Motor Vehicle <input type="checkbox"/> 355 Motor Vehicle Product Liability <input type="checkbox"/> 360 Other Personal Injury PERSONAL INJURY <input type="checkbox"/> 362 Personal Injury - Med. Malpractice <input type="checkbox"/> 365 Personal Injury - Product Liability <input type="checkbox"/> 368 Asbestos Personal Injury Product Liability PERSONAL PROPERTY <input type="checkbox"/> 370 Other Fraud <input type="checkbox"/> 371 Truth in Lending <input type="checkbox"/> 380 Other Personal Property Damage <input type="checkbox"/> 385 Property Damage Product Liability	<input type="checkbox"/> 610 Agriculture <input type="checkbox"/> 620 Other Food & Drug <input type="checkbox"/> 625 Drug Related Seizure of Property 21 USC 881 <input type="checkbox"/> 630 Liquor Laws <input type="checkbox"/> 640 R.R. & Truck <input type="checkbox"/> 650 Airline Regs. <input type="checkbox"/> 660 Occupational Safety/Health <input type="checkbox"/> 690 Other LABOR <input type="checkbox"/> 710 Fair Labor Standards Act <input type="checkbox"/> 720 Labor/Mgmt. Relations <input type="checkbox"/> 730 Labor/Mgmt. Reporting & Disclosure Act <input type="checkbox"/> 740 Railway Labor Act <input type="checkbox"/> 790 Other Labor Litigation <input type="checkbox"/> 791 Empl. Ret. Inc. Security Act	<input type="checkbox"/> 422 Appeal 28 USC 158 <input type="checkbox"/> 423 Withdrawal 28 USC 157 PROPERTY RIGHTS <input checked="" type="checkbox"/> 820 Copyrights <input checked="" type="checkbox"/> 830 Patent <input checked="" type="checkbox"/> 840 Trademark SOCIAL SECURITY <input type="checkbox"/> 861 HIA (1395ff) <input type="checkbox"/> 862 Black Lung (923) <input type="checkbox"/> 863 DIWC/DIWW (405(g)) <input type="checkbox"/> 864 SSID Title XVI <input type="checkbox"/> 865 RSI (405(g)) FEDERAL TAX SUITS <input type="checkbox"/> 870 Taxes (U.S. Plaintiff or Defendant) <input type="checkbox"/> 871 IRS—Third Party 26 USC 7609	<input type="checkbox"/> 400 State Reapportionment <input type="checkbox"/> 410 Antitrust <input type="checkbox"/> 430 Banks and Banking <input type="checkbox"/> 450 Commerce <input type="checkbox"/> 460 Deportation <input type="checkbox"/> 470 Racketeer Influenced and Corrupt Organizations <input type="checkbox"/> 480 Consumer Credit <input type="checkbox"/> 490 Cable/Sat TV <input type="checkbox"/> 810 Selective Service <input type="checkbox"/> 850 Securities/Commodities/Exchange <input type="checkbox"/> 875 Customer Challenge 12 USC 3410 <input type="checkbox"/> 890 Other Statutory Actions <input type="checkbox"/> 891 Agricultural Acts <input type="checkbox"/> 892 Economic Stabilization Act <input type="checkbox"/> 893 Environmental Matters <input type="checkbox"/> 894 Energy Allocation Act <input type="checkbox"/> 895 Freedom of Information Act <input type="checkbox"/> 900 Appeal of Fee Determination Under Equal Access to Justice <input type="checkbox"/> 950 Constitutionality of State Statutes
REAL PROPERTY <input type="checkbox"/> 210 Land Condemnation <input type="checkbox"/> 220 Foreclosure <input type="checkbox"/> 230 Rent Lease & Ejectment <input type="checkbox"/> 240 Torts to Land <input type="checkbox"/> 245 Tort Product Liability <input type="checkbox"/> 290 All Other Real Property	CIVIL RIGHTS <input type="checkbox"/> 441 Voting <input type="checkbox"/> 442 Employment <input type="checkbox"/> 443 Housing/Accommodations <input type="checkbox"/> 444 Welfare <input type="checkbox"/> 445 Amer. w/Disabilities - Employment <input type="checkbox"/> 446 Amer. w/Disabilities - Other <input type="checkbox"/> 440 Other Civil Rights	PRISONER PETITIONS <input type="checkbox"/> 510 Motions to Vacate Sentence Habeas Corpus: <input type="checkbox"/> 530 General <input type="checkbox"/> 535 Death Penalty <input type="checkbox"/> 540 Mandamus & Other <input type="checkbox"/> 550 Civil Rights <input type="checkbox"/> 555 Prison Condition		

V. ORIGIN

(Place an "X" in One Box Only)

- ☒ 1 Original Proceeding ☐ 2 Removed from State Court ☐ 3 Remanded from Appellate Court ☐ 4 Reinstated or Reopened ☐ 5 Transferred from another district (specify) ☐ 6 Multidistrict Litigation ☐ 7 Appeal to District Judge from Magistrate Judgment

VI. CAUSE OF ACTION

Cite the U.S. Civil Statute under which you are filing. (Do not cite jurisdictional statutes unless diversity):
Copyright Act, Title 17 U.S.C., and Trademark Act, Title 15 U.S.C.

Brief description of cause:
Declaratory Judgment action for Trademark, Trade Dress, and Copyright NON infringement.

VII. REQUESTED IN COMPLAINT:

☐ CHECK IF THIS IS A CLASS ACTION UNDER F.R.C.P. 23

DEMAND \$

CHECK YES only if demanded in complaint:

JURY DEMAND: ☒ Yes ☐ No**VIII. RELATED CASE(S) IF ANY**

(See instructions):

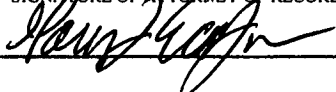
JUDGE

DOCKET NUMBER

DATE

SIGNATURE OF ATTORNEY OF RECORD

2/19/2008



FOR OFFICE USE ONLY

RECEIPT # 147930 AMOUNT \$350

APPLYING IFP

JUDGE

MAG. JUDGE

See 2/21/08

**UNITED STATES
DISTRICT COURT**
SOUTHERN DISTRICT OF CALIFORNIA
SAN DIEGO DIVISION

147936 - SH

**February 21, 2008
15:47:17**

Civ Fil Non-Pris

USAO #: 08CV0337

Judge.: JOHN A HOUSTON

Amount.: \$350.00 CK

Check#: BC2325

Total-> \$350.00

FROM: HST AUTOMOTIVE V. HALICKI ET AL